

REMARKS

Claims 45, 47, 49 and 51 have been amended as may be appreciated from the above listing of claims. The amendments do not alter the scope of those claims or otherwise place any new or additional burden on the Examiner. The amendments to the claims merely resolves the objections issued to these claims, as more fully discussed below.

No payment of fees for the amended claims is required for the amendment. Nevertheless, authorization is provided herewith to pay any underpayment of fees or credit any overpayment of fees to Deposit Account No. 02-4800.

I. OBJECTION TO CLAIMS 45, 47, 49, AND 51

The Examiner objected to claims 45, 47, 49 and 51 for using a term "configured for" or configured to" as not being positively recited and suggesting that some step is optional such that it does not limit the scope of claims 45, 47, 49 and 51 in the Office Action dated December 16, 2009 (hereafter "the Office Action"). The Examiner cited MPEP § 2106 as supporting the asserted objection. To the contrary, claims 45, 47, 49 and 51 are definite and do limit the scope of each claim. *See* MPEP § 2106. The basis of the cited support, MPEP § 2106, relates to patentable subject matter and does not in fact support the asserted objection.

"Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation." MPEP § 2106. "When evaluating the scope of a claim, every limitation in the claim must be considered. USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered." MPEP § 2106. USPTO personnel must always remember to use the perspective of

one of ordinary skill in the art. "Claims and disclosures are not to be evaluated in a vacuum. If elements of an invention are well known in the art, the applicant does not have to provide a disclosure that describes those elements." *Id.*

Claims 45, 47, 49 and 51 all claim patentable subject matter and have been amended to remove the "configured to" or "configured for" terms that appear to have been objected to by the Examiner in the Office Action dated December 16, 2009. It is respectfully requested that the objection to claims 45, 47, 49 and 51 be withdrawn.

II. RESPONSE TO THE REJECTION OF THE CLAIMS

The Examiner also rejected claims 45-46 as being rendered anticipated by U.S. Patent No. 5,740,374 to Raffali-Schreinemachers (hereafter "Raffali") in the Office Action. (Office Action, at 2).

Claims 33-35, 37, 39-44, and 47-51 were rejected as obvious in view of Raffali and U.S. Patent No. 6,229,818 to Bell. (Office Action, at 5).

Claim 36 was rejected as obvious in view of Raffali, Bell and U.S. Patent No. 7,274,704 to Ould-Brahim et al. (Office Action, at 19).

Claim 38 was rejected as obvious in view of Raffali, Bell and U.S. Patent No. 7,136,372 to Nilsen. (Office Action, at 21).

A. Burden of Proving Anticipation Under 35 U.S.C. § 102

"In order to demonstrate anticipation, the proponent must show that the four corners of a single, prior art document describe every element of the claimed invention." *Net Moneyin, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 88 U.S.P.Q.2d 1751, 1758, 2008 WL 4614511, *8 (Fed. Cir. 2008). The prior art reference relied upon to show anticipation "must not only disclose all

elements of the claim within the four corners of the document, but also disclose those elements arranged as in the claim." *Id.* "As arranged in the claim means that a reference that discloses all of the claimed ingredients, but not in the order claimed, would not anticipate because the reference would be missing any disclosure of the limitations of the claimed invention arranged as in the claim." *Id.* "The test is thus more accurately understood to mean arranged or combined in the same way as in the claim." *Id.*

B. Burden Of Proving Obviousness Under 35 U.S.C. § 103

"All words in a claim must be considered in judging the patentability of that claim against the prior art." MPEP § 2143.03 (emphasis added). "When evaluating claims for obviousness under 35 U.S.C. 103, **all the limitations of the claims must be considered and given weight.**" MPEP § 2143.03. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." *Id.* "A 35 U.S.C. 103 rejection is based on 35 U.S.C. 102(a), 102(b), 102(e), etc. depending on the type of prior art reference used and its publication or issue date." MPEP § 2141.01.

To establish a *prima facie* case of obviousness, an Examiner must show that an invention would have been obvious to a person of ordinary skill in the art at the time of the invention. MPEP § 2141. "Obviousness is a question of law based on underlying factual inquiries." *Id.* The factual inquiries enunciated by the Court include "ascertaining the differences between the claimed invention and the prior art" and "resolving the level of ordinary skill in the pertinent art." MPEP § 2141.

"A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art' at the time the claimed invention was made' because

the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." MPEP § 2143.01. "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, **there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.**" MPEP § 2143.01 (citing *KSR*, 82 U.S.P.Q.2d at 1396) (emphasis added).

For instance, an invention that permits the omission of necessary features and a retention of their function is an indicia of nonobviousness. *In re Edge*, 359 F.2d 896, 149 U.S.P.Q. 556 (CCPA 1966); MPEP 2144.04. A conclusory statement to the contrary is insufficient to rebut such an indicia of nonobviousness. *See* MPEP § 2143.01.

Moreover, "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." MPEP § 2143.01. Also, "the proposed modification cannot render the prior art unsatisfactory for its intended purpose." MPEP § 2143.01.

C. Claims 33-44 Are Allowable Over The Cited Art

Claim 33 defines a method for forwarding at least one signaling message with a network access unit of a third network. The method includes transmitting a signaling message from the originating unit to the network access unit by tunneling via the third network, determining that the signaling message is intended for a destination unit via the network access unit assessing the destination datum in a signaling message and converting the signaling message into the second signaling protocol if the second signaling protocol is different from the first signaling protocol

and transmitting the converted signaling message such that the converted signaling message is sent to the destination unit. Claims 34-44 depend directly or indirectly from claim 33 and, therefore, also require such a conversion of different protocols.

The Examiner rejected claims 33-44 as obvious in view of Raffali and Bell and other cited art. Raffali was cited as disclosing or suggesting all the steps of the method of claim 33 except for forwarding a signaling message without converting the signaling message to another signaling protocol if the first and second signaling protocols are identical. (Office Action, at 7). More importantly, Raffali also does not teach or suggest any network access unit determining which device a signaling message was intended for, nor converting a signaling message into a second protocol as required by claim 33 and the claims that depend from claim 33.

Raffali discloses a transmission system that converts messages into reference codes that are compatible with a reference protocol to permit tunneling with different protocols being used in the source and destination sub-networks. (Abstract). Each message is tunneled through sub networks. No access unit determines what device a message is intended for in Raffali. For instance, Raffali teaches translation members 8 that provide tunneling for messages to be sent through certain sub networks. Those translation members do not determine which destination device the message is intended for. (Col. 3, lines 49-53; Col. 5, lines 1-15).

The translation members disclosed by Raffali merely permit tunneling of a message through different sub networks. No access unit determines what device a message is being sent to and then converts that message into the protocol for that device and sends the message to a destination device. Indeed, there is no determination made by any access unit as to any

destination device. Each translation member merely encapsulates a message for use in a particular sub network. No determination is made by any translation member.

In fact, Raffali expressly teaches away from any determination by an access unit as required by claims 33-44. Raffali teaches that "transit traffic is transferred unchanged by means of tunneling." (Col. 3, lines 1-2). The tunneling performed in the system disclosed by Raffali merely encapsulates and decapsulates messages sent by an originating terminal. There is no determination of any destination unit made by any translation member or any access unit. For example, at Column 4, lines 22-47, Raffali teaches that headers and trailers of original messages are encapsulated and subsequently decapsulated by translation members for the message to pass through a particular sub network.

Further, Raffali does not teach or suggest any access unit that converts any message to a second protocol. The tunneling of a message by encapsulating the message does not convert a message into a protocol. Tunneling, as known in the art and as taught in Raffali, only utilizes slight changes to header and trailer portions of a message to a particular format. Such tunneling is not a conversion of a message as required by claims 33-44. In contrast, conversion relates to a conversion of an entire message. For example, a conversion of a signaling message in H.323 protocol into a signaling message of a different protocol, such as H.450. (*See Specification*, at paragraphs 53-55). Tunneling is all that is performed by the translation devices disclosed by Raffali, no conversion of messages is performed. (Abstract).

None of the other cited art teaches or suggests any conversion of messages or determinations by an access unit as required by claims 33-44. These claims are allowable over the cited art or any combination of cited art.

D. Claims 45-51 Are Allowable Over The Cited Art

Claim 45 requires a network access device for transmitting a signaling message having a first signaling protocol received from a first device in a first network to a second device in a second network to include a protocol conversion device that converts a signaling message having a first signaling protocol to a converted signaling message having a second signaling protocol that is different than the first signaling protocol. Claims 46-51 depend directly or indirectly from claim 45 and, therefore, also contain these limitations.

None of the cited art teach or suggest such a protocol conversion device in such a network access device. As discussed above, Raffali only teaches tunneling of messages. Raffali does not teach any device that converts signaling messages from one protocol to signaling messages of another protocol as required by claims 45-51.

1. Claims 47-50 Are Allowable

Claim 47 depends from claim 45 and requires the network access device to also include a decision device connected to the protocol conversion device. The decision device determines whether the signaling message requires conversion. Claims 48-50 depend directly or indirectly from claim 47 and therefore also include this limitation.

As discussed above with reference to claims 33-44, the cited art does not teach or suggest any network access device that includes any device that determines whether a signaling message requires conversion into a signaling message of a different protocol. For instance, the system disclosed by Raffali only teaches a system configured to tunnel messages through subnetworks. No message conversion, or conversion of messages into messages of other protocols, is taught or

suggested by Raffali. The header and trailer of messages are merely changed to encapsulate a message for tunneling.

E. Granted European Patent No. EP 1 535 477 Shows The Pending Claims Are Allowable

The present application corresponds to granted European Patent No. EP 1 535 477. A copy of this patent was provided with the Amendment filed on August 26, 2009. The European Patent Office has found the invention disclosed in the present application to warrant patent protection and granted claims of a scope comparable to the pending claims in this application. This is an indicia of the non-obvious nature of the pending claims and shows that the claims should be allowed.

III. CONCLUSION

For at least the above reasons, reconsideration and allowance of all pending claims is respectfully requested.

Respectfully submitted,

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Dated: February 9, 2010

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